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REMARKS

In the outstanding Office Action, the Examiner has rejected Claims 23-31, 35-37 and 42, and objected to Claims 32-34. Claims 23, 32, 35, and 42 have been amended, and Claims 38-41, 43, and 44 have been canceled. No new matter has been added. Thus, Claims 23-37 and 42 are presented for further examination. Reconsideration and allowance of all Claims 23-37 and 42 in light of the present remarks is respectfully requested.

Rejections Under 35 U.S.C. § 102(e)

The Examiner has rejected Claims 23-27, 35, and 42 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,987,317 to Venturini.

In regard to Claim 23, the Examiner stated that “Venturini discloses a method of providing a mailbox answerphone service (column 4, line 50 “messages”) to a caller (column 4, line 51 “users”) in a mobile communications system (34a on FIG. 2) during a call (column 7, line 14 “PBX responds”) directed to a directory number used commonly by different subscribers to access their mailboxes (column 1, lines 6-8), (which reads on “an automatic public/autonomous system message indicator recognition”), comprising: ... entering either a first mode of answerphone operation (column 8, line 52 “for a case the message is transmitted to the public network”) or a second, different, mode of answerphone operation in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal, the examiner considers this case as the national mode, since the limitation is either national mode or international mode].”

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053.

Amended Claim 23 recites a method of “providing a mailbox answerphone service to a caller in a mobile communications system during a call directed to a directory number used commonly by different subscribers to access their mailboxes, wherein the answerphone service is located in a first network and is responsive to calls originating from within the first network and from within a second network connected to the first network via international telecommunications links.” The method of Claim 23 comprises, *inter alia*, “entering a first mode

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of answerphone operation for a call originating from within the first network and a second, different mode of answerphone operation for a call originating from within the second network, wherein the answerphone service enters either the first or the second mode of operation in dependence on information received during call establishment indicating whether the call is of international origin.”

In Venturini, the mobile terminal may be registered with either an autonomous network 35 or a public network 32, wherein the autonomous network 35 includes a Private Branch Exchange (PBX) 31a, and wherein the public network includes a Message Center (MC) 34. *Col. 4, lines 25-27, lines 39-42; Fig. 2.* Thus, each network includes its own voice message service. In response to the user depressing a softkey, the mobile terminal examines the network registration indicator (NRI) information stored in memory to determine the network with which the mobile terminal is registered. The mobile terminal then dials the access code for the voice mailbox of this network to request retrieval of the voice messages stored in the voice mailbox. *Venturini, col. 8, lines 57-64.* Accordingly, only the voice message service associated with the network with which a mobile terminal is registered can be accessed by that mobile terminal.

In contrast to the system of Venturini, wherein each answerphone service is associated with one network, the mailbox answerphone service of Claim 23 can receive answerphone service requests originating from a plurality of networks. A difference in signaling between calls originating from different networks, such as a national and international network, creates a problem wherein a lack of CLI information is provided in international signaling. *See Applicant's specification at page 13, line 19 through page 14, line 2.* To resolve this problem, the answerphone service receives information during call establishment indicating whether the call is of international origin.

The signaling problem encountered in the service of Claim 23 is not encountered in the system described by Venturini because each network in Venturini's system has its own voice message system. Specifically, the PBX in the autonomous network cannot receive and process calls originating from subscribers outside of the autonomous network, and the message center in the public network cannot receive and process calls originating from subscribers outside of the public network. Thus, Venturini fails to describe or suggest an answerphone service located in first network and responsive to calls originating from within a second network connected to the first network via international communications links.

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In addition, Venturini neither describes nor suggests an answerphone service which receives information during call establishment indicating whether the call is of international origin, or that the answerphone service enters one of two modes of operation in dependence on the information received. Applicant notes that this feature was recited in Claim 23 prior to the present amendment and that therefore, Claim 23 was in condition for allowance as examined.

Applicant understands the Examiner's statement that "[t]he mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal, the examiner considers this case as the national mode, since the limitation is either national mode or international mode" as the Examiner construing "entering either a first mode of answerphone operation or a second, different, mode of answerphone operation" as an alternative feature. The Examiner previously stated that "Venturini fails to disclose the call is of international origin" in a previous rejection of Claim 23. *See Office Action dated June 6, 2003, page 7, line 20.* Thus, Applicant understands the Examiner's current rejection of Claim 23 to be as follows: Venturini teaches entering one mode of operation wherein such mode is construed as a national mode, and only one of either a national or an international mode needs to be described in the prior art to anticipate the claim. Applicant respectfully disagrees and submits that Venturini must describe an answerphone service which enters either a first or second mode of operation in dependence on information received during call establishment indicating whether the call is of international origin to anticipate Claim 23. As discussed above, Venturini fails to describe an answerphone service receiving a call of international origin and thus does not provide for two modes of operation.

Although Venturini fails to describe, either expressly or inherently, every element as set forth in Claim 23 as examined, Applicant has amended Claim 23 to clarify the features of the recited method. Thus, Applicant respectfully submits that amended Claim 23 is in condition for allowance and that no further search is required.

As amended Claims 35 and 42 recite limitations similar to those recited in the method of Claim 23, the arguments with respect to Claim 23 similarly apply to Claims 35 and 42, and thus, Claims 35 and 42 are respectfully submitted for further review as patentable subject matter.

Because Claims 24-27, 29, and 30 depend from Claim 23, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is

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therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features.

Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claim 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,987,317 to Venturini in view of U.S. Patent No. 5,497,373 to Hulen, et al. The Examiner has also rejected Claims 31, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,987,317 to Venturini in view of U.S. Patent No. 5,838,772 to Wilson, et al., and Claims 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Venturini in view of Wilson, and further in view of U.S. Patent No. 5,539,810 to Kennedy, III et al.

Because Claims 28-31, 36, and 37 depend from Claims 23 and 35, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed with respect to the independent claim, and for their other features.

Allowable Subject Matter

The Examiner stated that “Claims 32-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” Claim 32 has been rewritten in independent form including all of the limitations of the base claim, and therefore Applicant respectfully submits that Claim 32 is in condition for allowance. Consequently, because they incorporate all of the limitations of the claim from which they depend, Claims 33 and 34 also define patentable subject matter for at least the same reasons as set forth above with respect to the independent claim.

Applicant has endeavored to address all of the Examiner’s concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory section 102, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.


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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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